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Date:	August 31, 2006	Phone Number	Fax Number
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From:	Kevin J. Zilka		

Docket No.:   NVIDP322/P001314   **App. No: 10/049,972**

Total Number of Pages Being Transmitted, Including Cover Sheet: 39

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AUG 3 1 2006

Practitioner's Docket No. NVIDP322/ P001314   *PATENT*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Johnson et al.

Application No.: 10/049,972   Group No.: 2155
Filed: 02/13/2002   Examiner: Baturay, A.
For: INTERNET JACK

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P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF SUBSTITUTE APPEAL BRIEF
(PATENT APPLICATION--37 C.F.R. § 41.37)

1. This brief is in furtherance of the Notice of Appeal filed 05/2/2006, a substitute for the Appeal Brief filed 06/30/2006, and in response to the Notification of Non-Compliant Appeal Brief mailed on 08/01/2006.

2. STATUS OF APPLICANT

    This application is on behalf of other than a small entity.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*
(When using Express Mail, the Express Mail label number is mandatory; Express Mail certification is optional.)

I hereby certify that on the date shown below, this correspondence is being:

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✓_ facsimile transmitted to the Patent and Trademark Office, (571) 273 - 8300.

Signature

Date: 8/31/2006

Erica L. Farlow

(type or print name of person certifying)

* Only the date of filing (' 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under ' 1.8 continues to be taken into account in determining timeliness. See ' 1.703(f). Consider "Express Mail Post Office to Addressee" (' 1.10) or facsimile transmission (' 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

Transmittal of Appeal Brief–page 1 of 2

3.   FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. §1.17(c), the fee for filing the Appeal Brief has already been paid. However, the Commissioner is authorized to charge any fees that may be due to deposit account 50-1351 (Order No. NVIDP322).

4.   EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5.   TOTAL FEE DUE

The total fee due is:

        Appeal brief fee $0.00 (previously paid on June 30, 2006)
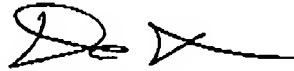   **Total Fee Due** $0.00

6.   FEE PAYMENT

Applicant believes that only the above fees are due in connection with the filing of this paper because the appeal brief fee was paid with a previous omission. However, the Commissioner is authorized to charge any additional fees that may be due (e.g. for any reason including, but not limited to fee changes, etc.) to deposit account 50-1351 (Order No. NVIDP322).

A duplicate of this transmittal is attached.

7.   FEE DEFICIENCY

If any additional extension and/or fee is required, and if any additional fee for claims is required, charge Deposit Account No. 50-1351 (Order No. NVIDP322).

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Transmittal of Appeal Brief—page 2 of 2

AUG 3 1 2006

☐ COPY *PATENT*

Practitioner's Docket No. NVIDP322/ P001314

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Johnson et al.

Application No.: 10/049,972   Group No.: 2155
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Date: 8/31/2006

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Erica L. Farlow

(type or print name of person certifying)

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* Only the date of filing (' 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under ' 1.8 continues to be taken into account in determining timeliness. See ' 1.703(f). Consider "Express Mail Post Office to Addressee" (' 1.10) or facsimile transmission (' 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

Transmittal of Appeal Brief—page 1 of 2

PAGE 4/37 * RCVD AT 8/31/2006 6:08:15 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/28 * DNIS:2738300 * CSID:4089714660 * DURATION (mm-ss):04-44

3.   FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. §1.17(c), the fee for filing the Appeal Brief has already been paid. However, the Commissioner is authorized to charge any fees that may be due to deposit account 50-1351 (Order No. NVIDP322).

4.   EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5.   TOTAL FEE DUE

The total fee due is:

          Appeal brief fee $0.00 (previously paid on June 30, 2006)
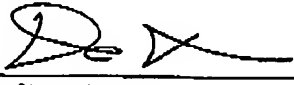   Total Fee Due $0.00

6.   FEE PAYMENT

Applicant believes that only the above fees are due in connection with the filing of this paper because the appeal brief fee was paid with a previous omission. However, the Commissioner is authorized to charge any additional fees that may be due (e.g. for any reason including, but not limited to fee changes, etc.) to deposit account 50-1351 (Order No. NVIDP322).

A duplicate of this transmittal is attached.

7.   FEE DEFICIENCY

If any additional extension and/or fee is required, and if any additional fee for claims is required, charge Deposit Account No. 50-1351 (Order No. NVIDP322).

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USA

Transmittal of Appeal Brief—page 2 of 2

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AUG 3 1 2006

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	)
	)
Johnson et al.	) Group Art Unit: 2155
	)
Application No. 10/049,972	) Examiner: Baturay, Alicia
	)
Filed: 02/13/2002	) Date: 08/31/2006
	)
For: INTERNET JACK	)
	)
	)
_____	)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

SUBSTITUTE APPEAL BRIEF (37 C.F.R. § 41.37)

This brief is in furtherance of the Notice of Appeal filed 05/2/2006, a substitute for the Appeal Brief filed 06/30/2006, and in response to the Notification of Non-Compliant Appeal Brief mailed on 08/01/2006 (see attached). While appellant disagrees with the Examiner as to whether the alleged deficiencies exist in the original Appeal Brief, a Substitute Appeal Brief with appropriate edits is nevertheless submitted to expedite prosecution.

The fees required under § 1.17, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 41.37(c)(i)):

I   REAL PARTY IN INTEREST

II   RELATED APPEALS AND INTERFERENCES

III   STATUS OF CLAIMS

- 2 -

The final page of this brief bears the practitioner's signature.

- 3 -

I REAL PARTY IN INTEREST (37 C.F.R. § 41.37(c)(1)(i))

The real party in interest in this appeal is NVIDIA Corporation.

- 4 -

II RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 41.37(c) (1)(ii))

With respect to other prior or pending appeals, interferences, or related judicial proceedings that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no other such appeals, interferences, or related judicial proceedings.

A Related Proceedings Appendix is appended hereto.

- 5 -

III STATUS OF CLAIMS (37 C.F.R. § 41.37(c) (1)(iii))

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-59

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims withdrawn from consideration: None
2. Claims pending: 1-59
3. Claims allowed: None
4. Claims rejected: 1-59
5. Claims cancelled: None

C. CLAIMS ON APPEAL

The claims on appeal are: 1-59

See additional status information in the Appendix of Claims.

- 6 -

IV STATUS OF AMENDMENTS (37 C.F.R. § 41.37(c)(1)(iv))

As to the status of any amendment filed subsequent to final rejection, there are no such amendments after final.

- 6 -

V SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. § 41.37(c)(1)(v))

With respect to a summary of Claims 1, and 27, as shown in Figures 1-5, an apparatus and method are provided for a user to connect an Internet-ready device (e.g. see item 270 of Figure 2, etc.) to the Internet (e.g. item 200 of Figure 2, etc.). Included are at least two connection ports (e.g. see items 411 and 441 of Figure 4, etc.). The first port (e.g. see item 441 of Figure 4, etc.) connects to an Internet conduit, and the second port (e.g. see item 411 of Figure 4, etc.) connects to the Internet-ready device (e.g. item 270 of Figure 2, etc.) capable of communicating utilizing Internet-related protocols. See, for example, page 11, line 20 – page 12, line 3 et al. In addition, the apparatus and method comprise a user interface (e.g. see item 400 of Figure 4, etc.), which allows a user to initiate passing information between the Internet-ready device and the Internet. See, for example, page 7, lines 3-10, and page 11, lines 20-25 et al. The user interface also has associated indicators to indicate to the user that the passing of information that was initiated by the user is complete. See, for example, page 7, lines 1-13 et al. Further, the apparatus and method comprise a protocol handler block (e.g. see item 102 of Figure 1, etc.) for receiving and handling messages from the user interface and from the Internet-ready device. Also, the protocol handler block sends on the handled messages to a network stack block (e.g. item 103 of Figure 1, and item 430 of Figure 4, etc.). See, for example, page 11, line 20 – page 12, line 3 et al. The network stack block handles an associated subset of the handled messages, and sends on to a physical connection block (e.g. item 440 of Figure 4, etc.). The physical connection block connects to the Internet (e.g. see item 450 of Figure 4, etc.). See, for example, page 11, line 20 – page 12, line 3 et al.

With respect to a summary of Claim 52, as shown in Figures 1-5, an apparatus is provided for a user to connect an Internet-ready device (e.g. see item 270 of Figure 2, etc.) to the Internet (e.g. item 200 of Figure 2). The apparatus is embedded into the Internet-ready device and comprises a user interface block (e.g. item 400 of Figure 4) to connect to the Internet-ready device, which capable of communicating utilizing Internet-related protocols. See, for example, page 11, lines 22-32 et al. In addition to the user interface block, the Internet-ready device comprises a physical connector block (e.g. item 440 of Figure 4, etc.) for connecting to the Internet (e.g. item 450 of Figure 4, etc.). See, for example, page 11, line 32 – page 12, line 3 et al.

- 8 -

With respect to a summary of Claims 11 and 37, as shown in Figures 1-5, the apparatus may be added easily to any of, but not limited to: set-top-boxes, Ethernet hubs, and hubs that are attached to new home networking standards. See, for example, page 8, lines 18-21 et al.

With respect to a summary of Claims 15 and 41, as shown in Figures 1-5, the apparatus further comprises a key code for passing from the Internet-ready device to the Internet. A pre-agreed upon algorithm is used to generate a response, where the response is sent back to said Internet-ready device, thereby authenticating the Internet connection to the Internet-ready device. See, for example, page 9, lines 22-28 et al.

With respect to a summary of Claims 16 and 42, as shown in Figures 1-5, the apparatus of Claims 15 and 41 is used in reverse to prevent unauthorized Internet-ready devices from accessing a particular site. See, for example, page 9, lines 22-28 et al.

- 8 -

**VI GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R. §
41.37(c)(1)(vi))**

Following, under each issue listed, is a concise statement setting forth the corresponding ground of
rejection.

Issue # 1: The Examiner has rejected Claim 57 under 35 U.S.C. 112, first paragraph, as failing to
comply with the enablement requirement.

Issue # 2: The Examiner has rejected Claim 57 under 35 U.S.C. 112, second paragraph, as being
indefinite.

Issue # 3: The Examiner has rejected Claims 1-12, 18-38, and 44-57 under 35 U.S.C. 102(e) as being
anticipated by Vaziri (U.S. Patent No. 6,377,570).

Issue # 4: The Examiner has rejected Claims 13-16, and 39-42 under 35 U.S.C. 103(a) as being
unpatentable over Vaziri in view of Himmel et al. (U.S. Patent No. 6,480,852).

Issue # 5: The Examiner has rejected Claims 17 and 43 under 35 U.S.C. 103(a) as being
unpatentable over Vaziri in view of Himmel in view of Martin et al. ("An Alternative to Government
Regulation and Censorship: Content Advisory Systems for the Internet").

Issue # 6: The Examiner has rejected Claim 58 under 35 U.S.C. 103(a) as being unpatentable over
Vaziri in view of Sharpe, III et al. (U.S. Patent No. 6,012,961).

Issue # 7: The Examiner has rejected Claim 59 under 35 U.S.C. 103(a) as being unpatentable over
Vaziri in view of Reavey et al. (U.S. Patent No. 5,847,698).

- 10 -

VII ARGUMENT (37 C.F.R. § 41.37(c)(1)(vii))

The claims of the groups noted below do not stand or fall together. In the present section, appellant explains why the claims of each group are believed to be separately patentable.

Issue # 1:

The Examiner has rejected Claim 57 under 35 U.S.C. 112, first and second paragraphs, as failing to comply with the enablement requirement and for being indefinite.

Group #1: Claim 57

The Examiner has maintained the rejection of Claim 57 under 35 U.S.C. 112, first paragraph, by simply reiterating that "[i]t is unclear how an Internet connection can be opened if the Internet is closed." Appellant again respectfully disagrees with such rejection, since appellant claims that "said closure of said Internet permits an Internet connection only to a website specified by said Internet-ready device" (emphasis added). It is thus readily apparent that appellant does not claim a "complete" closure, but rather a partial one that specifically permits an Internet connection only to a website specified by the Internet-ready device.

Issue # 2

The Examiner has rejected Claim 57 under 35 U.S.C. 112, second paragraph, as being indefinite.

Group #1: Claim 57

The Examiner has maintained the rejection of Claim 57 under 35 U.S.C. 112, second paragraph, by simply reiterating that "[i]t is unclear how an Internet connection can be opened if the Internet is closed." Appellant again respectfully disagrees with such rejection, since appellant claims that "said closure of said Internet permits an Internet connection only to a website specified by said Internet-ready device" (emphasis added). It is thus readily apparent that appellant does not claim

- 11 -

a "complete" closure, but rather a partial one that specifically permits an Internet connection only to a website specified by the Internet-ready device.

Issue # 3:

The Examiner has rejected Claims 1-12, 18-38, and 44-57 under 35 U.S.C. 102(e) as being anticipated by Vaziri (U.S. Patent No. 6,377,570).

Group #1: Claims 1-10, 12, 18-36, 38, 44-51, and 53-57

With reference to independent Claims 1 and 27, the Examiner has relied on the following excerpt from Vaziri to make a prior art showing of appellant's claimed "protocol handler block for receiving and handling messages from said user interface and from said Internet-ready device" (see this or similar, but not identical language in each of the foregoing claims).

> "Checking and sending messages will now be explained with reference to FIGS. 7D and 7E. To check messages, the user dials #3 to enter message checking through the menu. The ISB connects to the ISP and then connects through ISP 706 and Internet 712 to POP server 716. Once this last connection is achieved, the ISB downloads and plays the first message. The user can then dial 1 to repeat, 2 to go to the next message or 3 to erase a message, much as he would with an answering machine. To send a message, the user dials #4, whereupon the ISB connects to the ISP and then connects through ISP 706 and Internet 712 to SMTP server 718 (the function of the SMTP server having been described above). The user can then record a message and then send it via the SMTP server to the recipient's e-mail address. The ISB can be configured to impose a time limit on outgoing messages (e.g., 60 seconds). The ISB can also be configured to poll the ISP periodically (e.g., four times a day or some other interval which is either set in the factory or programmed by the user) to check for message and to give an indication to the user via an LED or the like when messages are waiting.
>
> The ISB can also be configured to poll the ISP periodically (e.g., four times a day or some other interval which is either set in the factory or programmed by the user), whenever a call is completed over IP, or both to check for message and to give an indication to the user via an LED or the like when messages are waiting. In one configuration, polling takes place only when all three of the following conditions are satisfied: (1) the polling period set in the ISB has expired, (2) the telephone has not been in use in the last two minutes and (3) no ring signal has been received in the last two minutes. Of course, the ISB can be equipped with an internal clock, such as those used in conventional IBM-compatible PCs, to allow periodic polling.

- 12 -

> Each voice mail message is stored on the recipient's POP server in the form of an e-mail message with the sender's e-mail address listed in the "From:" field, a standard subject such as "ISB voice mail message" and a MIME attachment of the voice mail message in an appropriate sound file format. If the recipient checks his e-mail on the POP server with a conventional e-mail program such as Eudora, he will see such message interspersed among conventional e-mail messages. The ISB can distinguish the voice mail messages from the conventional e-mail messages by the subject." (Col. 17, line 57 - col. 18, line 33)

Appellant respectfully asserts that the above excerpt from Vaziri only relates to messages from a telephone, not an "Internet-enabled device," as claimed (again, note that the Examiner now relies on Vaziri's help desk computer to meet appellant's claimed "Internet-enabled device"). Further, the messages of the above excerpt do not relate to messages from a "user interface" of an "apparatus for a user to connect an Internet-ready device to the Internet," as claimed, especially since the messages in Vaziri are from a telephone, and not from the help desk computer, as relied on by the Examiner. Thus, in no way is there even a suggestion of any sort of "protocol handler block for receiving and handling messages from said user interface and from said Internet-ready device," in the manner claimed by appellant (emphasis added). Appellant asserts that such use of Vaziri as a dictionary (i.e. by relying on a help desk computer as an Internet-enabled device and then relying on the functionality of a telephone) is simply inappropriate, and is further evidence that the prior art of record simply does not meet appellant's claims.

In the Advisory Action mailed 03/30/2006, the Examiner again relied upon Col. 17, line 57 to Col. 18, line 33 in Vaziri to make a prior art showing of appellant's claimed technique. Further, the Examiner argued that "the messages are converted from phone messages to email messages that are capable of being received at the help desk computer." First, appellant respectfully disagrees with the Examiner's statement. Appellant respectfully asserts that the excerpt from Vaziri merely teaches that a "user can then record a message and then send it via the SMTP server to the recipient's e-mail address." Vaziri continues, teaching that "[e]ach voice mail message is stored on the recipient's POP server in the form of an e-mail message." Additionally, Vaziri discloses that the "ISB connects to the ISP and then connects through ISP 706 and Internet 712 to POP server 716" where "the ISB downloads and plays the first message" (emphasis added). Clearly, sending a recorded message to an SMTP server, storing the message on the POP server, then the ISB downloading and playing the message from the POP server fails to support the Examiner's argument that Vaziri teaches "email messages that are capable of being received at the help desk computer." More importantly, appellant

- 13 -

respectfully asserts that the mere disclosure of an ISB that may download and play a message fails to even suggest a "protocol handler block for receiving and handling messages <u>from said user interface</u> <u>and</u> <u>from said Internet-ready device</u>" (emphasis added), as claimed by appellant. In addition, the disclosure of a SMTP server used to send a recorded message and an e-mail program to check for e-mail similarly fails to even suggest the same.

With additional reference to independent Claims 1 and 27, the Examiner has relied on the following excerpt from Vaziri to make a prior art showing of appellant's claimed protocol handler block for receiving and handling messages from said user interface and from said Internet-ready device, and for "sending on said handled messages to a network stack block" (see this or similar, but not identical language in each of the foregoing claims).

```
"More specifically, the ISB stores device, server, billing, and owner
information and a friends directory. The device information is
typically programmed into the ISB at the factory and includes the
serial number, the manufacturing date, the hardware version, the
software version, and the feature key, which identifies those features
which the ISB implements. The server information includes the IP
addresses for the various servers which the ISB needs to access, such
as the primary and backup ISBSSs. The owner information includes the
telephone number, the ISP access telephone number, any scripting
required to log onto the ISP, logon name and password, the domain names
or IP addresses for the SMTP and POP servers for e-mail, the e-mail
address, and the e-mail password. The SMTP server implements the simple
mail transfer protocol (SMTP) for sending e-mail, while the POP server
implements the post office protocol (POP) for receiving e-mail. Many
ISPs use the same server for both protocols. Other mail protocols exist
and can be used instead." (Col. 13, lines 13-31)
```

Appellant respectfully asserts that the above excerpt from Vaziri only relates to information with respect to the device, server, billing, owner information and friends directory that the Internet switch box (ISB) stores. Further, by virtue of the above arguments, there is not even a suggestion of any sort of <u>messages</u>, let alone sending <u>handled messages from said user interface</u> <u>and from said Internet-ready device</u> to a <u>network stack block</u>, in the manner claimed by appellant.

In the Office Action dated 01/27/06, the Examiner has stated that such excerpt in Vaziri teaches that "the ISB stores server information...the server information includes the IP address for various servers which the ISB needs to access...the domain names or IP addresses for the SMTP

- 14 -

and POP servers for e-mail...the SMTP server implements the simple mail transfer protocol (SMTP) for sending e-mail, which the POP server implements the post office protocol (POP) for receiving e-mail." Appellant again respectfully disagrees and asserts that the ISB only stores "device, server, billing, and owner information and a friends directory," none of which meet any sort of "sending on said handled messages," as appellant specifically claims (emphasis added).

In the Advisory Action mailed 03/30/2006, the Examiner again relied upon Col. 13, lines 13-31 to make a prior art showing of appellant's claimed technique. However, Vaziri's disclosure of using SMTP "for sending e-mail" and POP "for receiving e-mail" fails to meet "sending on said handled messages [from said user interface and from said Internet-ready device] to a network stack block" (emphasis added), as claimed by appellant. In addition, the Examiner relied upon Col. 2, line 8 and the mere disclosure of packets being sent over the Internet using TCP/IP. Appellant asserts that the Examiner's argument that "[a] network stack block is inherent in the TCP/IP protocol" still fails to take into consider the full weight of appellant's claim language, namely the claimed "sending on said handled messages" (emphasis added), in the context claimed.

Still with respect to independent Claims 1 and 27, the Examiner has relied on Figure 3 elements 304, 306, 307 and 311 along with Col. 11, lines 11-22 in Vaziri to make a prior art showing of appellant's claimed "indicators to indicate to said user that said passing of information that was initiated by said user is complete." Appellant emphasizes, however, that in the last Office Action dated 11/03/05, the Examiner admitted that Vaziri did not teach such claim language (see page 5 of the foregoing Office Action).

Nevertheless, appellant respectfully asserts that Vaziri expressly discloses that elements 304, 306, 307 and 311 are LEDs located on the ISB, and that such "LEDs may be used to indicate whether the power is on or off, the status of an Internet call attempt and whether any messages are waiting" along with "whether the menu feature is in use or whether an upgrade to the ISB software is available." Clearly, none of the functions taught by Vaziri meet appellant's claimed "indicators to indicate to said user that said passing of information that was initiated by said user is complete" (emphasis added).

- 15 -

In the Advisory Action mailed 03/30/2006, the Examiner argued that items 304, 306, 307, and 311 of Figure 3 and Col. 11, lines 11-22 disclose "status indicator LEDs...[which] may be used to indicate the status of an Internet call attempt." See below:
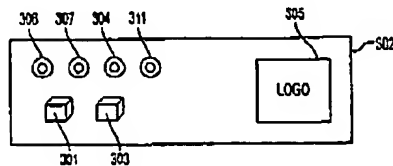

FIG. 3

"FIG. 3 shows a front or top view of an ISB. Front or top panel 302 may
include a logo 305. Status indicator LEDs 304, 306, 307 and 311 may be
provided. Three of these LEDs may be used to indicate whether the power is
on or off, the status of an Internet call attempt and whether any messages
are waiting. The fourth can be used in various ways, such as to indicate
whether the menu feature is in use or whether an upgrade to the ISB
software is available (in which case the software can be upgraded in a
manner to be described below). Of course, other configurations of LEDs can
be used, as can other interfaces such as an alphanumeric LCD display."
(Col. 11, lines 11-22 - emphasis added)

However, the mere disclosure of status indicator LEDs of which one may be used to indicate "the status of an Internet call attempt" fails to even suggest "indicators to indicate to said user that said passing of information that was initiated by said user is complete" (emphasis added), as claimed by appellant.

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.*868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

This criterion has simply not been met by the Vaziri reference, as noted above. Thus, a notice of allowance or a specific prior art showing of each of the foregoing claimed features, in combination with the remaining claimed features, is respectfully requested.

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Group #2: Claim 52

With respect to independent Claim 52, the Examiner has relied on the following excerpts from Vaziri to make a prior art showing of appellant's claimed "user interface block [used] to connect to said Internet-ready device" (see Claim 52).

> "Other than the user pressing a button (either on the ISB or telephone keypad) to initiate the Internet telephone call, the ISB takes care of all connection procedures (i.e., handshaking) necessary to set up and maintain the Internet telephone call. While both parties must possess an ISB in order to take advantage of the ISB's IT capabilities, only one party needs to initiate the telephone call in order to establish the Internet connection, so that prearrangement is not required." (Col. 3, lines 33-37)

> "FIG. 4 shows the back or bottom view of an ISB. Back or bottom panel 402 can include telephone jack 404 for connection to telephone 211, telephone jack 406 for connection to telephone line 212, optional port (serial, parallel, universal serial bus (USB), etc.) 408 for connection to another device such as a PC, and power jack 410." (Col. 12, lines 1-6; see also Figure 4)

In the Office Action dated 01/27/06, the Examiner has responded to appellant's arguments by relying on Vaziri's disclosure of a help desk computer or data terminal (item 908 of Figure 9) to meet appellant's claimed "Internet-ready device." Appellant respectfully asserts that, if the Examiner now relies on the help desk computer of Vaziri to meet appellant's claimed "Internet-ready device," the remaining claim elements are simply not met.

Specifically, the help desk computer in Vaziri uses an Internet switch box (ISB) to connect to the Internet. As shown in Figure 9, the ISB 100HD is separate from the help desk computer 908. Furthermore, Vaziri even discloses that the "specially equipped ISB 100HD [is] connected to [the] computer or data terminal 908 via a serial port or other connection such as serial port 408 of Figure 4" (see Col. 22, lines 27-33). Appellant notes that Vaziri only teaches that the ISB may be integrated within the telephone, but not within the help desk computer (see Col. 3, lines 21-23). Thus, Vaziri does not teach an "apparatus for a user to connect to an Internet-ready device to the Internet, where said apparatus is embedded into said Internet-ready device" and where the apparatus comprises "a user interface block to connect to said Internet-ready device," as claimed by appellant (emphasis added).

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In the Advisory Action mailed 03/30/2006, regarding the claimed "apparatus for a user to connect to an Internet-ready device to the Internet, where said apparatus is <u>embedded into said Internet-ready device</u>" (emphasis added), the Examiner cites Larson below from the MPEP.

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In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to
a fluid transporting vehicle was rejected as obvious over a prior art
reference which differed from the prior art in claiming a brake drum
integral with a clamping means, whereas the brake disc and clamp of the
prior art comprise several parts rigidly secured together as a single
unit. The court affirmed the rejection holding, among other reasons, "that
the use of a one piece construction instead of the structure disclosed in
[the prior art] would be merely a matter of obvious engineering choice.").
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The Examiner goes on to argue that "[b]ecause the Internet-ready device and the apparatus have the same functionality whether the apparatus is embedded in the Internet-ready device or not, the rejection stands."

Appellant respectfully disagrees with such assertion. First, attention is directed to Schenck below.

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Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)
(Claims were directed to a vibratory testing machine (a hard-bearing wheel
balancer) comprising a holding structure, a base structure, and a
supporting means which form "a single integral and gaplessly continuous
piece." Nortron argued that the invention is just making integral what had
been made in four bolted pieces. The court found this argument
unpersuasive and held that the claims were patentable because the prior
art perceived a need for mechanisms to dampen resonance, whereas the
inventor eliminated the need for dampening via the one-piece gapless
support structure, showing insight that was contrary to the understandings
and expectations of the art.)."
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First, the claimed apparatus does not have the same functionality whether the apparatus is embedded in the Internet-ready device or not, as purported by the Examiner. As indicated in the Background of the originally filed specification, many problems exist when using an apparatus in conjunction with a separate Internet-ready device. As further set forth in the originally filed specification, the claimed invention is thus cost affordable to embed into other devices, etc. Thus, like Schenck, appellant's novel integrated feature shows insight that was contrary to the understandings and expectations of the prior art, for the reasons noted above.

Group #3: Claims 11 and 37

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With respect to Claim 11 et al., the Examiner has relied on Col. 3, lines 64-66 in Vaziri to make a prior art showing of appellant's claimed apparatus "added easily to any of, but not limited to: set-top-boxes; Ethernet hubs; and hubs that are attached to new home networking standards." Appellant respectfully asserts that such excerpt only teaches that the "ISB may be incorporated into a telephone." Clearly, a telephone, as solely disclosed in Vaziri, does not meet appellant's claimed "set-top-boxes; Ethernet hubs; and hubs that are attached to new home networking standards."

In the Advisory Action mailed 03/30/2006, the Examiner argued that Col. 3, lines 64-66 in Vaziri teaches a "standalone adjunct device." Specifically, Vaziri discloses "an ISB [which] may be incorporated into a telephone or be a standalone adjunct device connected between the telephone and the telephone line" (emphasis added). Clearly, a standalone device connected between a telephone and telephone line fails to even suggest "set-top-boxes; Ethernet hubs; and hubs that are attached to new home networking standards," as claimed by appellant.

Issue # 4:

The Examiner has rejected Claims 13-16, and 39-42 under 35 U.S.C. 103(a) as being unpatentable over Vaziri in view of Himmel et al. (U.S. Patent No. 6,480,852).

   Group #1: Claims 13-14 and 39-40

Appellant respectfully asserts that the subject matter of such claims is deemed allowable in view of the arguments made hereinabove with respect to the independent Claims 1 and 27.

   Group #2: Claims 15 and 41

With respect to Claim 15 et al., the Examiner has relied on Col. 14, line 55-Col. 15, line 2 in Vaziri to make a prior art showing of appellant's claimed "key code for passing from said Internet-ready device to said Internet, whereupon a pre-agreed upon algorithm is used to generate a response, whereupon said response is sent back to said Internet-ready device, thereby authenticating said Internet connection to said Internet-ready device."

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Appellant respectfully asserts that such excerpt only generally teaches that the "ISB and the ISP perform any authentication procedure required" and that "the ISB and the ISP then start communication by PPP, and PAP (the password authentication protocol) is carried out if no authentication has been performed before." Clearly, only generally mentioning an authentication procedure and a default password authentication protocol, as in Vaziri, does not meet appellant's specific claim language, namely that "a <u>pre-agreed upon algorithm is used to generate a response</u>, whereupon said response is sent back to said Internet-ready device, thereby authenticating said Internet connection to said Internet-ready device" (emphasis added).

In the Advisory Action mailed 03/30/2006, the Examiner again argued that Col. 14, lines 55-66 in Vaziri discloses appellant's claimed technique of "a pre-agreed upon algorithm [that] is used to generate a response."

> 'Connection to the ISP will now be explained with reference to FIG. 7B. The modem is initialized, and telephone line 212 is monitored for a dial tone. ISB 100 dials the ISP access number to connect via PSTN 702 to modem rack 704 of the ISP. The modem of the ISB and a modem reached in modem rack 704 negotiate the baud rate and the protocol, whereupon ISB 100 is connected to the facilities of ISP 706. The **ISB and the ISP perform any authentication procedure required**, and the ISB selects "PPP" from the ISP's logon menu, if any. **The ISB and the ISP then start communication by PPP, and PAP (the password authentication protocol) is carried out if no authentication has been performed before.** The ISB is then connected by TCP to the ISP and thus via line 708, such as a T1 or T3 line or the like, to Internet backbone 710. If the call to the ISP results in a busy signal, the user can simply wait and call again. Alternatively, the ISB can be configured to store and dial multiple access numbers for one or more ISPs.' *(Col. 14, lines 55-66 - emphasis added)*

Appellant respectfully asserts that the excerpt from Vaziri relied upon by the Examiner merely discloses that "[t]he ISB and the ISP perform <u>any authentication procedure required</u>" (emphasis added). Further, Vaziri discloses that "[t]he ISB and the ISP then start communication by PPP, and <u>PAP (the password authentication protocol) is carried out if no authentication has been performed before</u>" (emphasis added). However, the mere disclosure that the ISB and the ISP perform authentication and PAP if no authentication has been performed before fails to even suggest a "key code for passing from said Internet-ready device to said Internet, <u>whereupon a pre-agreed upon algorithm is used to generate a response</u>, whereupon said response is sent back to said Internet-ready device, thereby authenticating said Internet connection to said Internet-ready device" (emphasis

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added), as claimed by appellant. Clearly, Vaziri's disclosure of using PAP fails to even suggest a
technique "whereupon a pre-agreed upon algorithm is used to generate a response," as claimed by
appellant.

Group #3: Claims 16 and 42

With respect to Claim 16 et al., the Examiner has again relied on Col. 14, line 55-Col. 15, line 2
in Vaziri to make a prior art showing of appellant's claimed "used in reverse to prevent
unauthorized Internet-ready devices from accessing a particular site." Appellant respectfully
asserts that such excerpt from Vaziri only relates to authenticating an ISB with an ISP, and not
"to prevent unauthorized Internet-ready devices from accessing a particular site," as appellant
claims (emphasis added).

In the Advisory Action mailed 03/30/2006, the Examiner argued that "[i]t is inherent that if a user
cannot be authenticated, then he or she is not authorized to access any site." Appellant respectfully
asserts that the Examiner's inherency argument for authentication fails to even address the full
weight of appellant's claimed technique "used in reverse to prevent unauthorized Internet-ready
devices from accessing a particular site." Clearly, the mere disclosure of PAP during authentication,
fails to even suggest "prevent[ing] unauthorized Internet-ready devices from accessing a particular
site" (emphasis added), as claimed by appellant.

Issue # 5:

The Examiner has rejected Claims 17 and 43 under 35 U.S.C. 103(a) as being unpatentable over
Vaziri in view of Himmel in view of Martin et al. ("An Alternative to Government Regulation and
Censorship: Content Advisory Systems for the Internet").

Group #1: Claims 17 and 43

Appellant respectfully asserts that the subject matter of such claims is deemed allowable in view of
the arguments made hereinabove with respect to the independent Claims 1 and 27

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Issue # 6:

The Examiner has rejected Claim 58 under 35 U.S.C. 103(a) as being unpatentable over Vaziri in view of Sharpe, III et al. (U.S. Patent No. 6,012,961).

Group #1: Claim 58

Appellant respectfully asserts that the subject matter of such claims is deemed allowable in view of the arguments made hereinabove with respect to the independent Claims 1 and 27.

Issue # 7:

The Examiner has rejected Claim 59 under 35 U.S.C. 103(a) as being unpatentable over Vaziri in view of Reavey et al. (U.S. Patent No. 5,847,698).

Group #1: Claim 59

Appellant respectfully asserts that the subject matter of such claims is deemed allowable in view of the arguments made hereinabove with respect to the independent Claims 1 and 27.

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VIII CLAIMS APPENDIX (37 C.F.R. § 41.37(c)(1)(viii))

The text of the claims involved in the appeal (along with associated status information) is set forth below:

1.   (Previously Presented) An apparatus for a user to connect an Internet-ready device to the Internet by an Internet connection independent means, comprising:

at least two connection ports, wherein the first port connects to an Internet conduit, and the second port connects to said Internet-ready device capable of communicating utilizing Internet-related protocols;

a user interface, allowing a user to initiate passing information between said Internet-ready device and said Internet, and having associated indicators to indicate to said user that said passing of information that was initiated by said user is complete;

a protocol handler block for receiving and handling messages from said user interface and from said Internet-ready device, and for sending on said handled messages to a network stack block;

said network stack block for handling an associated subset of said handled messages, and sending on to a physical connection block; and

said physical connection block for connecting to said Internet.

2.   (Original) The apparatus in Claim 1, wherein said indicators range from, but are not limited to, simple LED's to small LCD screens, cursor controls, and keyboards and/or keypads.

3.   (Original) The apparatus in Claim 1, further comprising a standard telephone jack connection.

4.   (Original) The apparatus in Claim 1, wherein said physical connection block comprises a data modem.

5.   (Original) The apparatus of Claim 4, wherein said data modem ranges from 2400 bps to 56 kbps, or wherein said data modem is an xDSL or cable modem.

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6.   (Original) The apparatus of Claim 1, wherein said network stack block handles all network, transport layer, and data link layer protocols needed for Internet connectivity.

7.   (Original) The apparatus of Claim 1, wherein said protocol handler provides any of the following application protocols: POP3, SMTP, HTTP, FTP, and DNS.

8.   (Original) The apparatus of Claim 1, whereby said apparatus is built as a standalone device.

9.   (Original) The apparatus of Claim 1, whereby said apparatus is built to be embedded into other devices.

10.   (Original) The apparatus of Claim 1, wherein said data modem is a cable modem.

11.   (Previously Presented) The apparatus of Claim 1, added easily to any of, but not limited to:

    set-top-boxes;

    Ethernet hubs; and

    hubs that are attached to new home networking standards.

12.   (Original) The apparatus of Claim 1, wherein said connection between said Internet-ready device and said Internet is closed in that said user never intervenes to provide additional information.

13.   (Original) The apparatus of Claim 1, further comprising a rating system, wherein said Internet-ready device passes a rating level to the Internet, whereupon only data not violating said rating level is passed back to said Internet-ready device.

14.   (Original) The apparatus of Claim 1, further comprising security schemes to prevent accessing information of unauthorized sites.

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15.   (Previously Presented) The apparatus of Claim 14, further comprising a key code for passing from said Internet-ready device to said Internet, whereupon a pre-agreed upon algorithm is used to generate a response, whereupon said response is sent back to said Internet-ready device, thereby authenticating said Internet connection to said Internet-ready device.

16.   (Original) The apparatus of Claim 15, used in reverse to prevent unauthorized Internet-ready devices from accessing a particular site.

17.   (Original) The apparatus of Claim 13, wherein said rating system is RSAC.

18.   (Original) The apparatus of Claim 1, wherein said initiating passing information between said Internet-ready device and said Internet is by said user pressing a button, thereby providing a one-touch operation.

19.   (Original) The apparatus of Claim 1, further comprising raw socket support.

20.   (Original) The apparatus of Claim 19, wherein said raw socket support further comprises any of, but is not limited to:
        support for multiple sockets;
        ability to set target and source port numbers; and
        TCP or UDP transport layers.

21.   (Original) The apparatus of Claim 1, wherein said protocol handler comprises a micro controller.

22.   (Original) The apparatus of Claim 21, wherein said micro controller provides Base64 and/or quoted printable data decoding.

23.   (Original) The apparatus of Claim 21, wherein said micro controller communicates directly with said Internet-ready device and with a raw socket.

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24.   (Original) The apparatus of Claim 1, further comprising multiple Internet-ready device connectors.

25.   (Original) The apparatus of Claim 1, further comprising auto BAUD rate detection for RS-232 type connections.

26.   (Original) The apparatus of Claim 5, further comprising a pass through port whereby an existing POTS appliance may be connected.

27.   (Previously Presented) A method for a user to connect an Internet-ready device to the Internet by an Internet connection independent means, comprising:

    providing at least two connection ports, wherein the first port connects to an Internet conduit, and the second port connects to said Internet-ready device capable of communicating utilizing Internet-related protocols;

    providing a user interface, allowing a user to initiate passing information between said Internet-ready device and said Internet, and having associated indicators to indicate to said user that said passing of information that was initiated by said user is complete;

    providing a protocol handler block for receiving and handling messages from said user interface and from said Internet-ready device, and for sending on said handled messages to a network stack block;

    providing said network stack block for handling an associated subset of said handled messages, and sending on to a physical connection block; and

    providing said physical connection block for connecting to said Internet.

28.   (Original) The method in Claim 27, wherein said indicators range from, but are not limited to, simple LED's to small LCD screens, cursor controls, keypads and/or keyboards.

29.   (Original) The method in Claim 27, further comprising providing a standard telephone jack connection.

30.   (Original) The method in Claim 27, wherein said physical connection block comprises a data modem.

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31.   (Original) The method of Claim 30, wherein said data modem ranges from 2400 bps to 56 kbps, or wherein said data modem is an xDSL and cable modem.

32.   (Original) The method of Claim 27, wherein said network stack block handles all network, transport layer, and data link layer protocols needed for Internet connectivity.

33.   (Original) The method of Claim 27, wherein said protocol handler provides any of the following application protocols: POP3, SMTP, HTTP, FTP, and DNS.

34.   (Original) The method of Claim 27, whereby standalone capability is provided.

35.   (Original) The method of Claim 27, whereby embeddable capability into other devices is provided.

36.   (Original) The method of Claim 27, wherein said data modem is a cable modem.

37.   (Previously Presented) The method of Claim 27, further providing easy connectivity to any of, but not limited to:
        set-top-boxes;
        Ethernet hubs; and
        hubs that are attached to new home networking standards.

38.   (Original) The method of Claim 27, wherein said connection between said Internet-ready device and said Internet is closed in that said user never intervenes to provide additional information.

39.   (Original) The method of Claim 27, further providing a rating system, wherein said Internet-ready device passes a rating level to the Internet, whereupon only data not violating said rating level is passed back to said Internet-ready device.

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40.   (Original) The method of Claim 27, further providing security schemes to prevent accessing information of unauthorized sites.

41.   (Original) The method of Claim 40, further providing a key code for passing from said Internet-ready device to said Internet, whereupon a pre-agreed upon algorithm is used to generate a response, whereupon said response is sent back to said Internet-ready device, thereby authenticating said Internet connection to said Internet-ready device.

42.   (Original) The method of Claim 41, used in reverse to prevent unauthorized Internet-ready devices from accessing a particular site.

43.   (Original) The method of Claim 39, wherein said rating system is RSAC.

44.   (Original) The method of Claim 27, wherein said initiating passing information between said Internet-ready device and said Internet is by said user pressing a button, thereby providing a one-touch operation.

45.   (Original) The method of Claim 27, further providing raw socket support.

46.   (Original) The method of Claim 45, wherein said raw socket support further comprises any of, but is not limited to:
    support for multiple sockets;
    ability to set target and source port numbers; and
    TCP or UDP transport layers.

47.   (Original) The method of Claim 27, wherein said protocol handler comprises a micro controller.

48.   (Original) The method of Claim 47, wherein said micro controller provides Base64 and/or quoted printable data decoding.

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49.   (Original) The method of Claim 47, wherein said micro controller communicates directly with said Internet-ready device and with a raw socket.

50.   (Original) The method of Claim 27, further providing multiple Internet-ready device connectors.

51.   (Original) The method of Claim 27, further providing auto BAUD rate detection for RS-232 type connections.

52.   (Previously Presented) An apparatus for a user to connect an Internet-ready device to the Internet, wherein said apparatus is embedded into said Internet-ready device, said apparatus comprising:

   a user interface block to connect to said Internet-ready device capable of communicating utilizing Internet-related protocols; and

   a physical connector block for connecting to the said Internet.

53.   (Original) The apparatus of Claim 52, further comprising a protocol handler block.

54.   (Original) The apparatus of Claim 52, wherein said embeddable devices comprise any of, but are not limited to:

   Internet capable phones;
   answering machines; and
   fax machines.

55.   (Original) The apparatus of Claim 31, further comprising a pass through port whereby an existing POTs appliance may be connected.

56.   (Previously Presented) The apparatus of Claim 1, wherein said Internet-ready device is embedded into an Internet-capable telephone.

57.   (Previously Presented) The apparatus of Claim 12, wherein said closure of said Internet permits an Internet connection only to a website specified by said Internet-ready device.

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58.   (Previously Presented) The apparatus of Claim 1, wherein said Internet-ready device includes a toy which emits sounds that are updated utilizing said Internet.

59.   (Previously Presented) The apparatus of Claim 1, wherein said Internet-ready device includes an electronic book.

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IX EVIDENCE APPENDIX (37 C.F.R. § 41.37(c)(1)(ix))
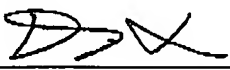
There is no such evidence.

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X RELATED PROCEEDING APPENDIX (37 C.F.R. § 41.37(c)(1)(x))

There is no such related proceeding.

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In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. NVIDP322/P001314).

Respectfully submitted,

By: _____ Date: ___08/31/2006___

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